

## **REMARKS/ARGUMENTS**

### **Introduction:**

Claims 19-29 have been newly added. In addition the specification and the drawings have been amended. Claims 1-29 are now pending in the application, although claims 16-18 are withdrawn. Applicants respectfully request reconsideration and reexamination of the application.

### **New Claims 19-29 Read On The Elected Species:**

All of new claims 19-29 read on the elected species, which is species E corresponding to Figure 8. For example, although claims 26-29 include "an energy transmissive device" or "a thermal element" or steps related to heating or cooling, the description of Figure 8 in the specification does not exclude the use of temperature-control devices or steps but expressly makes reference to the use of such devices or steps.

The specification describes Figure 8 as an exemplary embodiment in which a distance between a probe card and an electronic device under test is monitored and adjusted as needed. (See specification, pg. 16, second full paragraph.) The specification identifies the method of Figure 10 as an exemplary method for monitoring and adjusting the distance between the probe card and the electronic device and thus associates Figure 10 with Figure 8. (See specification, pg. 17, last paragraph.) The specification further states that the step in Figure 10 of adjusting the probe card (step 80) may include the use of "a particular corrective device or combination of devices *as previously described*." (See specification, pg. 18, first partial paragraph.) One such previously described device includes the energy transmissive devices 470 and 475 of Figure 4. Indeed, the specification expressly states that the energy transmissive devices 470 and 475 of Figure 4 may be used in the method of Figure 10 (see specification pg. 13, first full paragraph), which as discussed above, the specification associates with Figure 8. Therefore, the description of Figure 8 in the specification clearly contemplates the possible use of energy transmissive devices and the like with elected species E (Figure 8). Therefore, all of new claims 19-29 are readable on elected species E.

### **The Claims Are Definite:**

Claims 1-15 have been rejected under 35 USC § 112, second paragraph, as being indefinite. Applicants respectfully traverse this rejection.

The rejection under the second paragraph of 35 USC § 112 appears to be based on an alleged requirement that, following a Restriction and Election, the elected claims must be fully exemplified by only the figures that correspond to the elected species and all other parts of the specification must be ignored. Applicants believe the foregoing is error and is unsupported by the MPEP, Code of Federal Regulations, statutes, or case law. Should the Examiner persist in this rejection, Applicants respectfully request that the Examiner cite some authority (e.g., the MPEP, Code of Federal Regulations, statutes, or case law) in support of the proposition that the second paragraph of 35 USC § 112 requires that all elements of the claims be exemplified in any particular figure of the specification.

As described in the MPEP, the second paragraph of 35 USC § 112 requires nothing more than that the scope of the claims be reasonably clear to a person of ordinary skill in the field. (See MPEP §§ 2171, 2172, and 2173 for a discussion of the requirements of 35 USC § 112, second paragraph.) In the Office, there is no allegation—much less supporting argument—that persons of ordinary skill in the field would not understand the terms listed as allegedly unclear. To the contrary, each of those terms would be readily understood by a person of ordinary skill in the field. For example, a person of ordinary skill in the field would understand the term "temperature sensor" to be a device that senses temperature.

Moreover, the specification provides nonlimiting examples of each of those terms. For example, energy transmissive device 470 in Figure 4 is one example of a "means for transmitting energy to said probe card" (see Figure 4); a camera is one example of "an optical sensor" (see specification pg. 17, first full paragraph); communication cables 180a and 180b are examples of "means for data communication" (see Figure 11); a proximity sensor or a camera are two examples of a "means for measuring a distance" (see specification pg. 17, first full paragraph); a computer is disclosed as one example of a "means for electrically signaling in response" (see specification pg. 18, first partial paragraph), and a temperature sensing element is disclosed as an example of "a temperature sensor" (see specification pg. 12, last paragraph.)

For all of the foregoing reasons, the scope of the claims is reasonably clear. Therefore, all of the claims meet the requirements of 35 USC § 112, second paragraph. Consequently, the rejection under 35 USC § 112, second paragraph, should be withdrawn.

**The Claims Are Enabled:**

Claims 1-15 were also rejected under 35 USC § 112, first paragraph, because the specification allegedly does not enable a person of ordinary skill in the art to make and use the invention as claimed. Applicants respectfully traverse this rejection.

Like the rejection under the second paragraph of 35 USC § 112, the rejection under the first paragraph appears to be based on an alleged requirement that, following a Restriction and Election, the elected claims must be fully enabled by only the figures that correspond to the elected species and all other parts of the specification are ignored. Again, Applicants believe the foregoing is error and unsupported by the MPEP, Code of Federal Regulations, statutes, or case law. Should the Examiner persist in this rejection, Applicants respectfully request that the Examiner cite authority (e.g., the MPEP, Code of Federal Regulations, statutes, or case law) in support of the proposition that Applicants are not entitled to rely on the entire specification for compliance with the enablement requirement of the first paragraph of 35 USC § 112.

According to the MPEP, the test for determining whether the specification enables a claim is not whether one particular figure illustrates the claim but whether *the specification as a whole* provides sufficient information to enable a person of ordinary skill in the field to make and use the invention without undue experimentation. (See MPEP § 2164.) Again, there appears to be no allegation or supporting argument in the Office Action that a person of ordinary skill in the field could not make and use a "means for transmitting energy to said probe card to selectively deflect said probe card to control the geometric planarity of said probe card." Indeed, the specification describes energy transmissive devices 470 and 475 of Figure 4 as one example of such means, which the specification further states may be used to implement step 80 of Figure 10. (See specification pg. 13, first full paragraph; see also specification pg. 18, first paragraph.) With such information from the specification, a person of ordinary skill in the field would have little difficulty making and using the inventions claimed in claims 1-15. Therefore, the rejection under the first paragraph of 35 § 112 should be withdrawn.

### **Objection To The Drawings:**

The drawings were objected to as allegedly not showing "means for transmitting energy to said probe card" (claim 1), "an optical sensor" (claims 3 and 8), and "a temperature sensor" (claim 15). Elements 470 and 475, among other elements of the drawings, illustrate examples of "means for transmitting energy to said probe card." Moreover, Figures 4 and 8 are amended to illustrate an example of an optical sensor and a temperature sensor. Therefore, at least one example of "means for transmitting energy to said probe card," "an optical sensor," and "a temperature sensor" are now illustrated in the drawings. Therefore, the objection to the drawings has been overcome.

Again, should the Examiner persist in objecting to the drawings because claim elements are not illustrated in Figure 8 even though the claim elements are shown in other figures, Applicants respectfully request that the Examiner cite authority (e.g., from the MPEP) that 37 CFR 1.83(a) requires that, after a Restriction and an Election, each claim element be illustrated in one particular figure.

### **Withdrawn Claims 16-18:**

Applicants note the Examiner's statement that claims 16-18 continue to be withdrawn. Applicants note, however, that claim 1 is generic to (and thus a genus of) at least species A, E, and F of the Restriction of May 1, 2003. In addition, each of withdrawn claims 16-18 is generic to species F and at least one other species. Claim 1 is therefore a linking claim, that is, the inventions of claim 1 and withdrawn claims 16-18 are linked. (See MPEP § 809.03.) Applicants therefore request that, upon allowance of claim 1, claims 16-18 be rejoined and examined as required by the MPEP. (See MPEP § 809.)

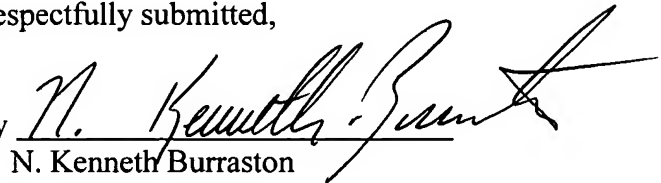
**Conclusion:**

In view of the foregoing, Applicants submit that all of the claims are allowable and the application is in condition for allowance. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

Date: September 8, 2004

By



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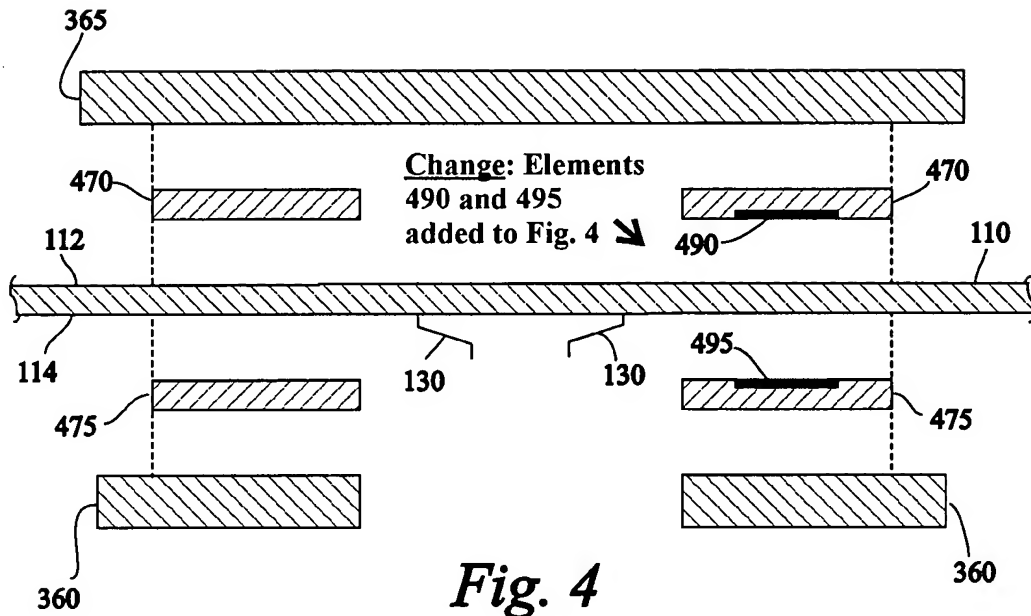
**Amendments to the Drawings:**

Attached are two Replacement sheets replacing originally filed sheet 3 (Figures 4, 4A, and 4B) and sheet 8 (Figure 8) of the drawings. On sheet 3, in Figure 4, temperature sensing elements 490 and 495 are added. On sheet 8, in Figure 8, camera 500 is added.

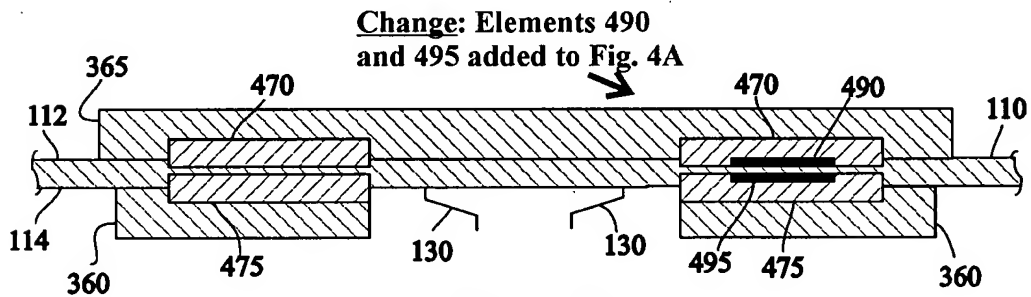
Attachment:           Two Replacement Sheets 3 And 8  
                          Two Annotated Sheets 3 And 8 Showing Changes



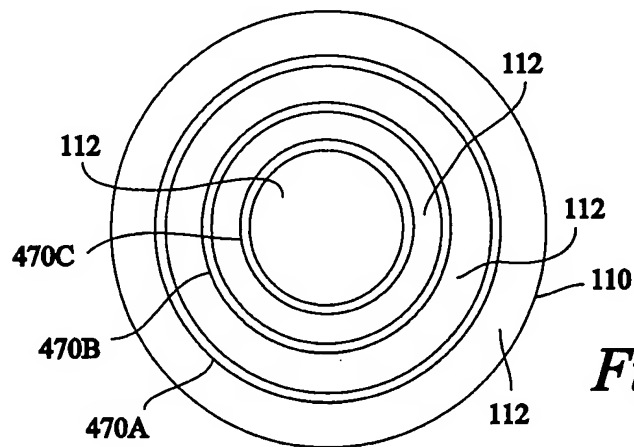
Appl. No. 10/034,412  
Amdt. Dated Sept. 8, 2004  
Reply to Office Action of April 8, 2004  
Annotated Sheet 3 Showing Changes



*Fig. 4*



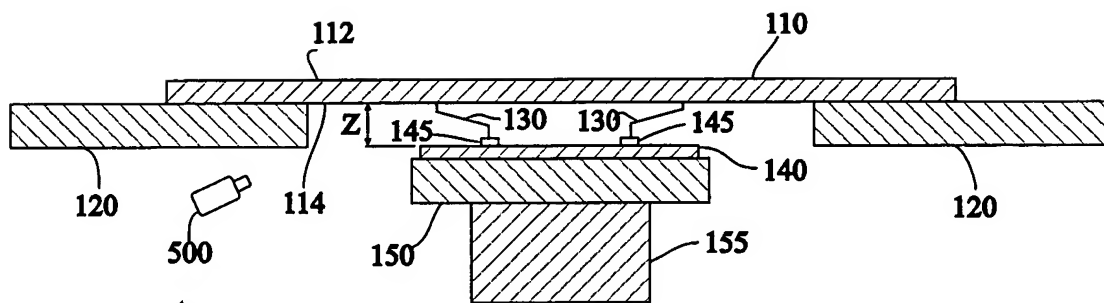
*Fig. 4A*



*Fig. 4B*



Appl. No. 10/034,415  
Amdt. Dated Sept. 8, 2004  
Reply to Office Action of April 8, 2004  
Annotated Sheet 8 Showing Changes



*Fig. 8*

Change: Element  
500 added to Fig. 8